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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,320	09/26/2003	Yohichiroh Watanabe	242938US0	5358

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

NOTIFICATION DATE	DELIVERY MODE
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07/30/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/670,320	Applicant(s) WATANABE ET AL.	
	Examiner Janis L. Dote	Art Unit 1756	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached.
 12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 6/7/07
 13. ☐ Other: _____.


JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1756

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1. The examiner has considered the IDS's filed on Aug. 31, 2006, and Mar. 6, 2007. A corrected copy of the form PTO-1449 filed on Aug. 31, 2006, and a copy of the examiner-initiated copy of the form PTO-1449 filed on Mar. 6, 2007, were attached to the final rejection that was electronically mailed to applicants on Apr. 12, 2007. See the office action summary form PTOL-326 mailed on Apr. 12, 2007, continuation sheet; and Public Pair at USPTO.gov, "List of references cited by applicant and considered by the examiner," mailed on Apr. 12, 2007, for copies of the corrected form PTO-1449 filed on Aug. 31, 2006, and the examiner-initialed form PTO-1449 filed on Mar. 6, 2007.

2. The rejections under 35 U.S.C. 103(a) of claims 1, 3, 8-12, and 15-28 over US 2003/0138717 (Yagi) in the final office action mailed on Apr. 12, 2007, paragraphs 6 and 7, wherein Yagi was considered to qualify as prior art under 35 U.S.C. 102(e), have been withdrawn because Yagi has been shown not to be prior art under 35 U.S.C. 102(e) and under 35 U.S.C. 103(c). Applicants' representative has shown that Yagi and the instant application were owned by the same person at the time the invention in the instant application was made. See the remarks filed on Jul. 9, 2007, page 2, lines 5-7.

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However, the rejections under 35 U.S.C. 103(a) of claims 1, 3, 8-12, and 15-28 over (Yagi), in the final office action, paragraphs 6 and 7, wherein Yagi qualifies as prior art under 35 U.S.C. 102(a), stand. Contrary to applicants' statement, they have not perfected their claim to foreign priority under 35 U.S.C. 119 to the priority document, Japanese patent application No. 2002-365782. Applicants have not indicated where in the certified English-language translation of said priority document filed on Jul. 9, 2007, there is an adequate written description of the subject matter recited in instant claims 1, 3, 8-12, and 15-28. The examiner has not found where the limitations recited in the instant claims are described in the translation as set forth under 35 U.S.C. 112, first paragraph. For example, with respect to independent claims 1, 21, 24, and 26, the translation does not appear to disclose that the particulate material comprises a particulate resin having a glass transition temperature (T_g) of from "40 to 100°C" as recited in those claims. Rather, the translation at page 7, lines 24-26, and page 16, lines 16-17, discloses that the particulate resin has a T_g of 55 to 100°C. The translation also does not appear to disclose that the particulate resin has a "weight average molecular weight of 9,000 to 200,000" or that the "particulate resin is included in the toner particles in an

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amount of 0.5 to 5.0% by weight based on total weight of the toner particles" as recited in the independent claims. In addition, the translation does not appear to disclose that the binder resin comprises tetrahydrofuran-insoluble components in an amount of from 1 to 15 % by weight as recited in instant claim 21. Nor does the translation appear to broadly describe the toner composition that is not required to be made by particular method disclosed in the translation as recited in instant independent claim 24.

Accordingly, applicants have not perfected their claim to foreign priority for the subject matter recited in the instant claims. Yagi remains as prior art with respect to the subject matter recited in instant claims 1, 3, 8-12, and 15-28.

The provisional obviousness-type double patenting rejection of claims 1, 3, 8-24, 26, and 28 over claims 26 and 28-50 of Application 11/475,165, set forth in the final rejection, paragraph 9, stands for the reasons of record because applicants have not provided any arguments traversing the rejection. In addition, contrary to applicants' comments, the provisional rejection is not the only issue in the application. Thus, the rejection is maintained.